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10 APPLE GMBH.; APPLE RETAIL  
11 GERMANY GMBH; APPLE, JAPAN INC.;  
12 APPLE SALES INTERNATIONAL;  
13 APPLE HOLDING B.V.; APPLE  
14 BENELUX B.V.; APPLE NETHERLANDS  
15 B.V.; APPLE RETAIL NETHERLANDS  
16 B.V.; APPLE KOREA LTD.; APPLE  
17 FRANCE; APPLE RETAIL FRANCE;  
18 APPLE ITALIA S.R.L.; APPLE RETAIL  
19 UK LIMITED; and APPLE PTY LIMITED.

20 **UNITED STATES DISTRICT COURT**  
21 **SOUTHERN DISTRICT OF CALIFORNIA**

22 *In re* Ex Parte Application of

23 APPLE INC.; APPLE GMBH; APPLE  
24 RETAIL GERMANY GMBH; APPLE,  
25 JAPAN INC.; APPLE SALES  
26 INTERNATIONAL; APPLE HOLDING  
27 B.V.; APPLE BENELUX B.V.; APPLE  
28 NETHERLANDS B.V.; APPLE RETAIL  
NETHERLANDS B.V.; APPLE KOREA  
LTD.; APPLE FRANCE; APPLE RETAIL  
FRANCE; APPLE ITALIA S.R.L.; APPLE  
RETAIL UK LIMITED; and APPLE PTY  
LIMITED.

Applicants,

For an Order Pursuant to 28  
U.S.C. § 1782 Granting Leave  
to Obtain Discovery from  
Qualcomm Inc. for Use in  
Foreign Proceedings.

Civil Action No. 11MC1268

**EX PARTE APPLICATION FOR AN  
ORDER PURSUANT TO 28 U.S.C. § 1782  
GRANTING LEAVE TO OBTAIN  
DISCOVERY FOR USE IN FOREIGN  
PROCEEDINGS AND SUPPORTING  
MEMORANDUM**

Apple<sup>1</sup> applies to the Court ex parte<sup>2</sup> for an order pursuant to 28 U.S.C. § 1782 granting Apple leave to obtain targeted discovery from Qualcomm Inc. (“Qualcomm”) for use in foreign litigations.

## I. INTRODUCTION

Samsung Electronics Co., Ltd. and its affiliates have sued Apple for infringement and injunctions in no fewer than eight countries outside of the United States. These lawsuits allege Apple’s products infringe patents Samsung has declared essential to the Universal Mobile Telecommunications System (UMTS) standard. Under 28 U.S.C. § 1782, interested parties, such as Apple, may obtain discovery for use in foreign litigations from companies located within the United States.

In support of its defenses to the actions filed by Samsung against Apple in South Korea, Japan, Germany, the Netherlands, the United Kingdom, France, Italy and Australia, Apple seeks narrowly tailored discovery from its supplier of certain wireless communication chips, Qualcomm. Specifically, Apple seeks documents regarding whether Qualcomm had or has a license or is or was otherwise authorized to practice some or all of the patents that have been asserted by Samsung against Apple. With particular reference to France, the discovery requested by Apple is urgent because Samsung has filed for a preliminary injunction and the Court has granted a hearing date of October 20, just 15 days from now.

<sup>1</sup> Except as otherwise indicated, as used herein “Apple” means Apple Inc.; Apple GmbH; Apple Retail Germany GmbH; Apple, Japan Inc.; Apple Sales International; Apple Holding B.V.; Apple Benelux B.V.; Apple Netherlands B.V.; Apple Retail Netherlands B.V.; Apple Korea Ltd.; Apple France; Apple Retail France; Apple Italia s.r.l.; Apple Retail UK Limited; and Apple Pty Limited.

<sup>2</sup> Ex parte filing of applications are “an acceptable method for seeking discovery pursuant to [28 U.S.C.] section 1782.” *In re Application of Republic of Ecuador*, No. 22-MC-0052, 2011 U.S. Dist. LEXIS 103360 (E. D. Cal. Sept. 13, 2011); *see also In re Ecuador*, No. C-10-80225, 2010 U.S. Dist. LEXIS 102158, at \*7 (N.D. Cal. Sept. 15, 2010) (“[I]t is common for the process of presenting the request to a court and to obtain the order authorizing discovery to be conducted ex parte. Such ex parte applications are typically justified by the fact that the parties will be given adequate notice of any discovery taken pursuant to the request and will then have the opportunity to move to quash the discovery or to participate in it”) (internal quotation marks and citations omitted).

1 Apple's application satisfies section 1782's three statutory requirements. First, it is filed  
2 in "the district in which [the] person resides," 28 U.S.C. § 1782(a), because Qualcomm's  
3 headquarters are in San Diego, California. Second, Apple seeks the discovery "for use in a  
4 proceeding in a foreign . . . tribunal," *id.*, including courts such as the Mannheim Regional Court  
5 in Germany and the Tokyo District Court in Japan. Third, Apple and its foreign subsidiaries  
6 qualify as "interested persons" in those foreign proceedings because they are named parties to  
7 those proceedings. *See id.*; *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 256  
8 (2004) (litigants are common example of "interested persons").

10 Moreover, the factors identified by the Supreme Court to guide courts' discretion in  
11 analyzing applications under section 1782 all favor granting Apple's request. Qualcomm is not a  
12 participant in the foreign proceedings, and section 1782 provides an effective mechanism for  
13 obtaining this targeted discovery across various cases. In addition, the foreign jurisdictions at  
14 issue are receptive to the type of discovery sought by Apple, the discovery provides key  
15 information for the foreign proceedings, and the request is not made to circumvent any limitation  
16 on discovery imposed by the foreign courts. Finally, the discovery request is narrowly tailored  
17 and is not unduly intrusive or burdensome. Accordingly, Apple respectfully requests that the  
18 Court enter the order attached as Exhibit A and allow Apple to serve the subpoena attached as  
19 Exhibit B.

## 22 II. FACTUAL BACKGROUND

23 Samsung has filed lawsuits against Apple in the United States, before the International  
24 Trade Commission, and in eight countries outside of the United States. In each of the suits  
25 outside of the United States, Samsung has focused its patent infringement allegations on patents  
26 Samsung has declared essential to the UMTS standard. (*See generally* Selwyn Decl. at ¶¶ 4-27.)  
27  
28

1 The functionalities accused by Samsung in these actions generally relate to the chips within the  
2 iPhone and iPad, some of which are supplied by Qualcomm. (*Id.* at ¶ 30.)

3 Samsung's European lawsuits are pending in Germany's Mannheim Regional Court (*id.*  
4 at ¶ 4), the District Court of the Hague in the Netherlands (*id.* at ¶ 10), the Paris Civil Court in  
5 France (*id.* at ¶ 116), the Court of Milan - IP Chamber in Italy (*id.* at ¶ 19), and the High Court of  
6 Justice, Chancery Division, Patents Court in the United Kingdom (*id.* at ¶ 22). In all, Samsung  
7 alleges that Apple infringes seven European patents by selling mobile devices that purportedly  
8 comply with portions of the UMTS standard. (*Id.* at ¶¶ 6, 12, 18, 21, 24, and 27.)

9  
10 In addition, Samsung has sued Apple in the Federal Court of Australia (*id.* at ¶ 25).  
11 There, Samsung has asserted seven Australian patents, all of which Samsung has claimed are  
12 essential to the UMTS standard.

13  
14 Samsung has also sued Apple in the Seoul Central District Court in South Korea, alleging  
15 infringement of five Korean patents. (*Id.* at ¶¶ 13-15.) Samsung argues that four of these patents  
16 are essential to the UMTS standard and that therefore compliance with the UMTS standard  
17 necessarily infringes. (*Id.*)

18  
19 In Japan, Samsung has filed two patent actions against Apple in the Tokyo District Court,  
20 alleging infringement of two Japanese patents. (*Id.* at ¶¶ 7-9.) Samsung's infringement  
21 allegations in its Japanese actions are also based on the UMTS standard. (*Id.*)

22 Finally, Samsung has opened another front in its ongoing worldwide campaign to enjoin  
23 Apple from allegedly practicing its Declared Essential patents. In the Federal Court of Australia,  
24 New South Wales District, Samsung's lawsuit alleges that Apple infringes seven Australian  
25 patents. (*Id.* at ¶¶ 25-27.) The alleged infringement of Samsung's patents is again based on  
26 Apple's sales of mobile devices which comply with the UMTS standard.  
27  
28

1 **III. ARGUMENT**

2 **A. Legal Standard.**

3 Section 1782 is “the product of congressional efforts, over the span of nearly 150 years,  
4 to provide federal-court assistance in gathering evidence for use in foreign tribunals.” *Intel*  
5 *Corp.*, 542 U.S. at 247. Over time, Congress has “substantially broadened the scope of  
6 assistance federal courts could provide for foreign proceedings.” *Id.* at 247-249.

7 Section 1782 provides in part:

8  
9 The district court of the district in which a person resides or is  
10 found may order him to give his testimony or statement or to  
11 produce a document or other thing for use in a proceeding in a  
12 foreign or international tribunal . . . . The order may be made . . .  
13 upon the application of any interested person and may direct that  
14 the testimony or statement may be given, or the document or other  
15 thing be produced, before a person appointed by the court.

16 28 U.S.C. § 1782(a). The statute thus sets forth three requirements, authorizing the district court  
17 “to grant a Section 1782 application where (1) the person from whom discovery is sought resides  
18 or is found in the district of the district court to which the application is made, (2) the discovery  
19 is for use in a proceeding before a foreign tribunal, and (3) the application is made by a foreign  
20 or international tribunal or any interested person.” *Chevron Corp. v. E-Tech Int’l.*, Case No. 10-  
21 cv-1146, 2010 U.S. Dist. LEXIS 94396, at \* 11 (S.D. Cal. Sept. 10, 2010) (internal quotation  
22 marks and citations omitted).

23 In *Intel*, the Supreme Court set forth several non-exclusive factors to aid district courts in  
24 determining how to exercise their discretion in granting section 1728 applications. These factors  
25 include: (1) whether “the person from whom discovery is sought is a participant in the foreign  
26 proceeding”; (2) “the nature of the foreign tribunal, the character of the proceedings underway  
27 abroad, and the receptivity of the foreign government or the court or agency abroad to U.S.  
28 federal-court judicial assistance”; (3) whether the request is “an attempt to circumvent foreign



1 proof-gathering restrictions or other policies of a foreign country or the United States”; and (4)  
 2 whether the discovery is “unduly intrusive or burdensome.” *Intel*, 542 U.S. at 264-65; *Chevron*  
 3 *Corp.*, 2010 U.S. Dist. LEXIS 94396, at \*11 (outlining *Intel* factors).

4  
 5 **B. Apple’s Application Meets the Section 1782 Requirements.**

6 Apple’s request for discovery meets each of the three statutory requirements. First, the  
 7 person from whom discovery is sought, Qualcomm, “resides or is found” in this District. 28  
 8 U.S.C. § 1782(a). Qualcomm has its principal place of business at 5775 Morehouse Drive, San  
 9 Diego, California, which is located within this District. (Selwyn Decl. Ex. A (excerpt of 2010  
 10 Qualcomm 10K).)

11 Second, the discovery is sought for use in a “proceeding before a foreign tribunal.” 28  
 12 U.S.C. § 1782(a). Specifically, Apple seeks the information for use in establishing at least the  
 13 defenses of license, unfair competition and/or antitrust violations in patent infringement actions  
 14 brought by Samsung in one or more foreign tribunals: the Mannheim Regional Court, District  
 15 Court of the Hague, Paris Civil Court, Court of Milan - IP Chamber, the High Court of Justice,  
 16 Chancery Division, Patents Court in the United Kingdom, Seoul Central District Court, Tokyo  
 17 District Court, and the Federal Court of Australia, New South Wales District. All these venues  
 18 are courts of first impression for hearing patent litigation.  
 19  
 20

21 As previous cases have recognized, these and related foreign adjudicative bodies qualify  
 22 as “tribunals” for purposes of section 1782. *See, e.g., Marubeni Am. Corp. v. LBA Y.K.*, 335 Fed.  
 23 App’x. 95, 97-98 (2d Cir. 2009) (permitting discovery for use in “Japanese District Court in  
 24 Tokyo”); *Cryolife, Inc. v. Tenaxis Medical, Inc.*, No. C08-05124 HRL, 2009 U.S. Dist. LEXIS  
 25 3416, at \*1, 5 (N.D. Cal. Jan. 13, 2009) (permitting discovery for use in patent infringement suit  
 26 pending in “Dusseldorf Regional Court in Germany”); *In re Qwest Commcns. Int’l Inc.*, No. 08-  
 27 93, 2008 U.S. Dist. LEXIS 115845, at \*1, 8, 15 (W.D.N.C. July 10, 2008) (permitting discovery  
 28

1 for proceeding in “Amsterdam District Court” and noting that “courts have routinely held that  
 2 the courts of the Netherlands are ‘tribunals’ under Section 1782”); *In re Sveaas*, 249 F.R.D. 96,  
 3 108 (S.D.N.Y. 2008) (permitting discovery for use in cases pending in “Court of Paris”);  
 4 *Lancaster Factoring Co. Ltd. v. Mangone*, 90 F.3d 38, 39-41 (2d Cir. 1996) (permitting  
 5 discovery for use in bankruptcy proceeding in “Court of Milan”); *In re IKB Deutsche*  
 6 *Industriebank AG*, No. 09-cv-7852, 2010 WL 1526070, at \*2 (April 8, 2010 N.D. 111.) (venue  
 7 for commercial dispute in United Kingdom “qualifies as a foreign or international tribunal”)  
 8 (internal quotation mark omitted); *Beluga Shipping GMBH v. Suzlon Energy Ltd.*, Case No. 10-  
 9 80034 JW, 2010 U.S. Dist. LEXIS 104705, at \*8 (Sept. 23, 2010) (permitting section 1782  
 10 discovery for use in an Australian proceeding).

11  
 12  
 13 Third, as named parties in the foreign actions, Apple and its subsidiaries qualify as  
 14 “interested part[ies].” 28 U.S.C. § 1782(a); *Intel*, 542 U.S. at 256 (“No doubt litigants are  
 15 included among . . . the ‘interested person[s]’ who may invoke § 1782”); *see also Heraeus*  
 16 *Kulzer, GmbH v. Biomet, Inc.*, 633 F.3d 591, 594 (7th Cir. 2011); *Qwest*, 2008 U.S. Dist. LEXIS  
 17 115845, at \*9. Accordingly, Apple has satisfied the statutory requirements for an application  
 18 under 28 U.S.C. § 1782.  
 19

20 **C. The Supreme Court’s *Intel* Factors Strongly Favor Granting Apple’s**  
 21 **Application.**

22 In addition, the factors identified by the Supreme Court in *Intel* and by other courts weigh  
 23 heavily in favor of the Court exercising its discretion to grant Apple’s request for discovery.

24 **1. Qualcomm Is Not a Party in the Foreign Proceedings.**

25 Since Qualcomm is not a party to the foreign litigations, the material Apple seeks,  
 26 licenses in Qualcomm’s possession, may not be within the foreign tribunal’s jurisdictional reach.  
 27 *See Intel*, 542 U.S. at 264 (noting that “nonparticipants in the foreign proceeding may be outside  
 28

1 the foreign tribunal's jurisdictional reach; hence, their evidence, available in the United States,  
 2 may be unobtainable absent § 1782 aid"); *see also Heraeus Kulzer*, 633 F.3d at 597 (authorizing  
 3 section 1782 discovery because German litigant could not "obtain even remotely comparable  
 4 discovery by utilizing German procedures"); *Cryolife*, 2009 U.S. Dist. LEXIS 3416 at \*13  
 5 (holding that "petitioner need only show that the information" sought under section 1782 "will  
 6 be useful").<sup>3</sup>

## 8 **2. Apple Seeks Highly Relevant Information that Will Assist the Foreign** 9 **Courts.**

10 The nature and character of the foreign proceedings and the receptivity of the foreign  
 11 courts to U.S. federal-court judicial assistance also weigh in favor of this Court granting Apple's  
 12 request for discovery. *See Intel*, 542 U.S. at 264. Because the nature and character of the  
 13 foreign proceedings involve Samsung's allegations of patent infringement, discovery regarding  
 14 potentially relevant license agreements is critical. *See London v. Does*, 279 F. App'x 513, 515  
 15 (9th Cir. 2008) (affirming order granting 1782 discovery where proof sought was "critical" in  
 16 light of the "nature and character of the foreign case"); *In re Bayer AG*, 146 F.3d 188, 195-96  
 17 (3d Cir. 1998) (documents relevant to the foreign proceedings are "presumptively discoverable"  
 18 under section 1782).

19 Moreover, prior cases have recognized the receptiveness of the jurisdictions at issue here  
 20 to the use of discovery obtained through section 1782. *See e.g., Heraeus Kulzer*, 633 F.3d at 597  
 21 (Germany); *Cryolife*, 2009 U.S. Dist. LEXIS 3416, at \*8-9 (same); *Marubeni*, 335 Fed. App'x. at  
 22 98 (Japan); *In re Letters Rogatory from the Tokyo District Prosecutor's Office*, 16 F.3d 1016,  
 23 1020-21 (9th Cir. 1994) (same); *In re Roche Nederland B.V.*, No. 11-0017, slip op. at 1 (M.D.  
 24

25  
 26  
 27 <sup>3</sup> Nor are the relevant Samsung entities all parties to each of the foreign proceedings. For example, the plaintiff in  
 28 the German actions is Samsung GmbH, not Samsung Electronics. Obtaining discovery from the relevant Samsung  
 entity may thus be difficult or impossible in that suit.



Term. May 12, 2011) (Selwyn Decl. Ex. B) (Netherlands); *Qwest*, 2008 U.S. Dist. LEXIS 115845, at \*12-13 (same); *Euromepa S.A. v. R. Esmerian, Inc.*, 51 F.3d 1095, 1097, 1101 (2d Cir. 1995) (France); *Lancaster Factoring*, 90 F.3d at 42 (Italy); *IKB Deutsche Industriebank*, 2010 WL 1526070, at \*4 (United Kingdom); *In re Request for Judicial Assistance from the Seoul District Criminal Court*, 428 F. Supp. 109, 111, 114 (N.D. Cal. 1977), *aff'd*, 555 F.2d 720 (9th Cir. 1977) (South Korea); *see also In re Procter & Gamble Co.*, 334 F. Supp. 2d 1112, 1115-16 (United Kingdom, France, The Netherlands, Germany, and Japan); *Beluga Shipping*, 2010 U.S. Dist. LEXIS 104705, at \*8 (Australia).

### 3. No Foreign Discovery Restrictions Bar Apple's Requested Discovery.

28 U.S.C. § 1782 does not require that the documents sought be discoverable in the foreign courts. *Intel*, 542 U.S. at 260-63. However, a district court could consider whether an applicant was seeking in bad faith “to circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United States.” *Id.* at 265.<sup>4</sup> Here, Apple is unaware of any restrictions on proof-gathering procedures that would prohibit obtaining the discovery it seeks through section 1782. To the contrary, as noted above, U.S. courts have routinely granted applications under section 1782 for evidence to be used in the foreign courts at issue here. *See e.g., Heraeus Kulzer*, 633 F.3d at 597 (Germany); *Marubeni*, 335 Fed. App'x. at 98 (Japan); *Qwest*, 2008 U.S. Dist. LEXIS 115845, at \* 12-13 (Netherlands); *Seoul District Criminal Court*, 428 F. Supp. 109 (South Korea); *Lancaster Factoring*, 90 F.3d at 42 (Italy); *Sveaas*, 249 at 108 (France); *IKB Deutsche Industriebank*, 2010 WL 1526070, at \*4 (United Kingdom); *Beluga Shipping*, 2010 U.S. Dist. LEXIS 104705, at \*8 (Australia).

<sup>4</sup> *See also In Re Esses*, 101 F.3d 873, 876 (2d Cir. 1996) (“[O]nly upon authoritative proof that a foreign tribunal would *reject* evidence obtained with the aid of section 1782 should a district court refrain from granting the assistance offered by the act”) (emphasis in original); *Euromepa*, 90 F.3d at 1101 (permitting discovery under section 1782 and observing that court “can simply refuse to consider any evidence that [1782 applicant] gather by what might be – under French procedures – an unacceptable practice”); *Procter & Gamble*, 334 F. Supp. 2d at 1116 (holding that “to decline a § 1782(a) request based on foreign nondiscoverability, a district court must conclude that the request would undermine a specific policy of a foreign country or the United States”).

1                   **4. Apple's Discovery Is Narrowly Tailored to Avoid Undue Burden.**

2           Apple's proposed discovery requests are narrowly tailored and minimally burdensome.  
3       *See Intel*, 542 U.S. at 265 ("unduly intrusive or burdensome requests may be rejected or  
4       trimmed"). Apple is requesting document discovery on only two topics, targeted to a small,  
5       discrete set of documents: intellectual property licenses between Qualcomm and Samsung and  
6       communications regarding these licenses. The universe of responsive documents is thus likely to  
7       be small and easily searchable, avoiding any undue burden on Qualcomm.  
8

9                   **5. Granting Apple's Section 1782 Request Would Promote Efficient**  
10                   **Discovery.**

11           In addition to the *Intel* factors, courts have also considered other evidence suggesting that  
12       the discovery sought accomplishes the goals of section 1782, such as whether the requested  
13       discovery "provid[es] efficient means of assistance to participants in international litigation in  
14       our federal courts." *Marubeni*, 335 F. App'x at 96 (internal quotation omitted). Here, given the  
15       worldwide, complex nature of the litigations between Apple and Samsung, section 1782 provides  
16       an effective means for obtaining the discovery sought by Apple. Rather than seeking the same  
17       discovery in each of the foreign litigations, Apple can obtain the discovery with one application  
18       under section 1782. *See Procter & Gamble*, 334 F. Supp. 2d at 1115 (observing that it would be  
19       inefficient to require party to patent infringement actions in Germany, Japan, the Netherlands,  
20       France and the United Kingdom "to seek the same discovery" in each of them).  
21

22                   **6. The Court Should Exercise Its Discretion and Grant Apple's Request.**

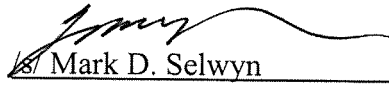
23           The *Intel* factors, and other factors considered by the courts, all strongly favor the Court  
24       exercising its discretion to grant Apple's application. Courts in this Circuit routinely permit  
25       discovery under section 1782 where, as here, the applicant has satisfied the three statutory  
26       requirements and the *Intel* factors all support granting the requested relief. *See, e.g., In re Am.*  
27  
28

1 *Petroleum Institute*, 11-80008-JF (PSG), slip op. (N.D. Cal. Apr. 7, 2011) (Selwyn Decl. Ex. C);  
2 *In re Ecuador*, 2010 WL 3702427, at \*2, *London*, 279 F. App'x at 513; *Chevron Corp.*, 2010  
3 U.S. Dist. LEXIS 94396, at \*11; *Govan Brown & Assocs. v. Doe*, No. 10-2704-PVT, 2010 U.S.  
4 Dist. LEXIS 88673, at \*7-8 (N.D. Cal. Aug. 6, 2010); *Mirana v. Battery Tai-Shing Corp.*, No.  
5 08-80142, slip op. (N.D. Cal. Sept. 19, 2008) (Selwyn Decl. Ex. D).

7 **IV. CONCLUSION**

8 Apple seeks narrowly tailored discovery for use in eight currently pending foreign  
9 proceedings, one of which has an injunction hearing date of October 20 and thus places urgency  
10 on Apple's requested discovery. Because Apple's request satisfies the three statutory  
11 requirements of 28 U.S.C. § 1782 and because the *Intel* factors all weigh in favor of granting the  
12 application, Apple respectfully requests that this Court issue the proposed order attached as  
13 Exhibit A, authorizing the issuance of a subpoena in substantially the same form as Exhibit B.  
14

15 Dated: October 5, 2011

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